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BRENDA POMERANCE				
LAW OFFICE OF BRENDA POMERANCE				
310 West 52 Street				
Suite 27B				
NEW YORK, NY 10019				
EXAMINER				
BAYAT, BRADLEY B				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* BRENDA POMERANCE
9

10 Appeal 2008-0100
11 Application 09/543,049
12 Technology Center 3600
13
14

15
16 Decided: November 21, 2008
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18

19 *Before:* MURRIEL E. CRAWFORD, ANTON W. FETTING, and DAVID
20 B. WALKER, *Administrative Patent Judges.*
21
22 CRAWFORD, *Administrative Patent Judge.*
23

24 DECISION ON APPEAL

25
26 STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 46-63 and 85-89¹. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm-in-part.

Appellant invented a method for processing a complaint in an automated alternative dispute resolution process (Specification 2:14-17).

Claim 46, reproduced below, is further illustrative of the claimed subject matter:

46. A method of processing a complaint, comprising:
automatically receiving, at a computer, initial information from a complainer including information identifying the complainer,
automatically selecting, at the computer, selected data from data previously received from a complaineer based on the initial information from the complainer,
automatically providing, from the computer, the selected data to the complainer,
automatically receiving, at the computer, additional information from the complainer after providing the selected data to the complainer,
automatically preparing, at the computer, the complaint based on the initial information and the additional information received from the complainer,
automatically presenting, from the computer, the prepared complaint to the complainer for approval to generate an approved complaint, and

¹ Claims 82-84 have been allowed and claims 1-45 and 64-81 have been cancelled.

1 automatically forwarding, from the
2 computer, the approved complaint, including the
3 information identifying the complainer, to the
4 complainee.
5

6 The prior art relied upon by the Examiner in rejecting the claims on
7 appeal is:

8 Sloo	US 5,895,450	Apr. 20, 1999
9 McFarland	US 6,154,753	Nov. 28, 2000
10 Thiessen	US 5,495,412	Feb. 27, 1996

11
12 *Online Mediation Offered for Resolving E-Commerce Disputes*, Press
13 Release, Online Resolution (23 March 2000) (hereinafter referred to as
14 “Online Resolution”).

15
16 Eisen, Joel, *Are We Ready for Mediation in Cyberspace*, 199 Brigham
17 Young Univ. Law Review 1305-58 (1998) (hereinafter referred to as
18 “Eisen”).

19
20 Brownwell, Eileen O., *Say it Right*, IIE Solutions (February 1999)
21 (hereinafter referred to as “Brownwell”).
22

23 The Examiner rejected claims 46, 48, 50, 52, 53 and 54 under 35
24 U.S.C. § 103(a) as being unpatentable over Sloo in view of Online
25 Resolution.

26 The Examiner rejected claims 47, 55-58, and 61-63 under 35 U.S.C.
27 § 103(a) as being unpatentable over Sloo in view of Online Resolution, and
28 further in view of Eisen.

29 The Examiner rejected claims 49 and 59 under 35 U.S.C. § 103(a) as
30 being unpatentable over Sloo in view of Online Resolution and Eisen, and
31 further in view of Brownwell.

The Examiner rejected claims 51 and 60 under 35 U.S.C. § 103(a) as being unpatentable over Sloo in view of Online Resolution and Eisen, and further in view of McFarland.

The Examiner rejected claims 85, 88, and 89 under 35 U.S.C. § 103(a) as being unpatentable over Sloo in view of Thiessen.

The Examiner rejected claim 86 under 35 U.S.C. § 103(a) as being unpatentable over Sloo in view of Thiessen, and further in view of Eisen.

The Examiner rejected claim 87 under 35 U.S.C. § 103(a) as being unpatentable over Sloo in view of Thiessen, and further in view of McFarland.

ISSUES

The first issue is whether the Appellant has shown that the Examiner erred in holding that it would have been obvious to a person of ordinary skill in the art in view of the combined teachings of Sloo and Online Resolution to modify the Sloo method so as to include the step of “automatically forwarding, from the computer, the approved complaint, including the information identifying the complainer, to the complaine.”

The second issue is whether the Appellant has shown that the Examiner erred in holding that it would have been obvious to a person of ordinary skill in the art in view of the combined teachings of Sloo, Online Resolution, and Eisen to modify the Sloo method so as to include the steps of “automatically forwarding, at the computer, preparing the complaint including emotional state information based on the information received from the complainer.”

The third issue is whether the Appellant has shown that the Examiner erred in holding that it would have been obvious to a person of ordinary skill in the art in view of the combined teachings of Sloo and Thiessen to modify the Sloo method so as to include the steps of “automatically receiving, at the computer, a response to the at least one suggested remedy.”

FINDINGS OF FACT

Appellant invented a method for processing a complaint in an automated alternative dispute resolution process (Specification 2:14-17).

Customer 20 sends a complaint to AADR system 60 (Specification 6:5-6).

AADR system 60 processes the complaint into a complaint summary by, among other things, filtering emotional venting from the complaint so as to ameliorate emotional ranting (Specification 6:6-11 and 17-19; 9:6-10; Appeal Brief 5).

Indeed, this filtering of emotional reactions is one of the key functions of the invention (Specification 4:6-10).

Customer 20 then approves the complaint summary (Specification 10:11-12).

Sloo discloses a method, computer program, and apparatus for handling, processing, and resolving complaints between consumers and vendors (col. 1, ll. 13-15).

The consumer enters a complaint including their phone number, e-mail address, and personal “complaint resolved” password (col. 4, l. 61 through col. 5, l. 17).

The complaints received by the vendors are anonymous (col. 1, ll. 17-25 and 55-58; col. 6, ll. 42-46).

The complaint may include evidence gathered by an evidence gathering module, for example, audio, video, and satisfaction data (col. 12, ll. 25-61).

Online Resolution discloses that dispute negotiations may be conducted over e-mail, instant messaging and threaded discussions (Online Resolution 1).

Online Resolution also teaches that emotions are a big part of the mediation process (Online Resolution 2).

Eisen discloses that it is undesirable to filter cathartic feelings and emotions out of the online mediation process (Eisen 5).

PRINCIPLES OF LAW

“A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

“[A] combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731 (2007).

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a

different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

In re Keller, 642 F.2d 413, 425 (CCPA 1981).

Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one. *See Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1322, 50 USPQ2d, 1865, 1870 (Fed. Cir. 1999) (stating that “not every process claim is limited to the performance of its steps in the order written”). However, such a result can ensue when the method steps implicitly require that they be performed in the order written. *See Loral*, 181 F.3d at 1322, 50 USPQ2d at 1870 (stating that “the language of the claim, the specification and the prosecution history support a limiting construction[, in which the steps must be performed in the order written,] in this case”); *Mantech*, 152 F.3d at 1376, 47 USPQ2d at 1739 (holding that “the sequential nature of the claim steps is apparent from the plain meaning of the

claim language and nothing in the written
description suggests otherwise’).

Interactive Gift Express, Inc. v. CompuServe Inc., 256 F.3d 1323, 1342-43
(Fed. Cir. 2001).

ANALYSIS

Obviousness Rejection of Claims 46, 48, 50, 52, 54

We are not persuaded that the Examiner erred in holding that it would
have been obvious to a person of ordinary skill in the art in view of the
combined teachings of Sloo and Online Resolution to modify the Sloo
method so as to include the step of “automatically forwarding, from the
computer, the approved complaint, including the information identifying the
complainer, to the complaine.”

Sloo discloses presenting an anonymous complaint from a consumer
to a vendor by, among other things, removing the phone number and e-mail
address initially provided by the consumer (col. 1, ll. 17-25 and 55-58; col.
4, l. 61 through col. 5, l. 17; col. 6, ll. 42-46; Examiner’s Answer 4).
Appellant argues that this is evidence of a teaching away (Appeal Brief 9-
10). As to the specific question of “teaching away,” our reviewing court in
In re Gurley, 27 F.3d at 553 stated:

A reference may be said to teach away when a
person of ordinary skill, upon [examining] the
reference, would be discouraged from following
the path set out in the reference, or would be led in
a direction divergent from the path that was taken
by the applicant.

1 Sloo teaches that one may want to file an anonymous complaint if the
2 consumer does not want to file a face-to-face complaint due to
3 inconvenience or embarrassment. However, Sloo does not discourage a
4 complainant that does not find it inconvenient or embarrassing to file a non-
5 anonymous complaint. As such, Sloo does not teach away from the claimed
6 invention.

7 In addition, we are not persuaded by Appellant's argument that it was
8 improper to combine the teachings of Sloo and Online Resolution because
9 Sloo teaches anonymous complaints and Online Resolution does not. While
10 it is true that Sloo discloses that anonymous complaints may be *sought*, there
11 are only two options for a complaint. Either the complaint is non-
12 anonymous and includes information identifying the complainer, or the
13 complaint is anonymous and excludes such information. The fact that the
14 inventor in Sloo *sought* the latter option in no way suggests that the former
15 option was *unknown* (Examiner's Answer 16-17). Indeed, the fact that the
16 inventor in Sloo went into lengthy detail about the undesirability of non-
17 anonymous communications and how to remove personal information from
18 the complaint to make it anonymous shows that the inventor was aware of
19 non-anonymous options, how they work, and the results of their use (col. 1,
20 ll. 17-25 and 55-58; col. 5, l. 61 through col. 6, l. 17; col. 6, ll. 42-46;
21 Examiner's Answer 4). Accordingly, we agree with the Examiner that the
22 implementation of a non-anonymous complaint was *known* and the means
23 for going about the implementation, adding information identifying the
24 complainer, was *known* and *predictable* (Examiner's Answer 15-16). *See*
25 *KSR Int'l Co.*, 127 S. Ct. at 1731. This argument is further bolstered by the
26 Examiner's citation of Online Resolution as disclosing negotiations

1 conducted over e-mail, instant messaging, and threaded discussions, all of
2 which would include the exchange of identifying information (Online
3 Resolution 1).

4 We have carefully considered the Declarations of Nora Femenia and
5 Christina Kallas, but remain unpersuaded that the Examiner improperly
6 combined Sloo and Online Resolution. The core of the arguments set forth
7 in the Declarations are (1) mediation and arbitration are different fields
8 (Declaration of Nora Femenia ¶¶ 8-12; Declaration of Christina Kallas ¶¶ 7-
9 11) and (2) bodily incorporating Online Resolution into Sloo would not
10 result in the claimed invention (Declaration of Nora Femenia ¶ 15;
11 Declaration of Christina Kallas ¶ 14).

12 When a work is available in one field of endeavor,
13 design incentives and other market forces can
14 prompt variations of it, either in the same field or a
15 different one. If a person of ordinary skill can
16 implement a predictable variation, § 103 likely
17 bars its patentability. For the same reason, if a
18 technique has been used to improve one device,
19 and a person of ordinary skill in the art would
20 recognize that it would improve similar devices in
21 the same way, using the technique is obvious
22 unless its actual application is beyond his or her
23 skill.

24
25 *KSR Int'l Co.*, 127 S. Ct. at 1740.

26 We are not persuaded that mediation and arbitration are different
27 fields in an obviousness context. Both are related to dispute resolution, and
28 an individual practicing one of arbitration or mediation would be familiar
29 with methods and techniques in the other. In any case, we are unpersuaded

1 that it would be beyond the skill of a person in mediation or arbitration to
2 add information identifying the complainer to a complaint. *See id.*

3 Concerning the second point, the test of obviousness is not whether
4 features of a secondary reference may be bodily incorporated into a primary
5 reference's structure, nor whether the claimed invention is expressly
6 suggested in any one or all of references. Rather, the test is what the
7 combined teachings of references would have suggested to those of ordinary
8 skill in art. *See In re Keller*, 642 F.2d at 425. Accordingly, the result of
9 bodily incorporating Online Resolution into Sloo is irrelevant unless
10 Appellant can show that this bodily incorporation would teach that adding an
11 e-mail address to a complaint was unknown and the results unpredictable.
12 Appellant did not make such a showing.

13 We will sustain this rejection.

14
15 *Obviousness Rejection of Claims 47, 55-58, 61-63*

16 We are not persuaded that the Examiner erred by asserting that a
17 combination of Sloo, Online Resolution, and Eisen renders obvious
18 “automatically, at the computer, preparing the complaint including
19 emotional state information based on the information received from the
20 complainer” as set forth in independent claim 55².

21 The Examiner cites Online Resolution and Eisen as disclosing the
22 importance of emotions in negotiations (Online Resolution 2; Eisen 5;
23 Examiner’s Answer 17-18). Sloo discloses an evidence recording module

² Page 5 of the Appeal Brief cites the following in the written description as support for this aspect of claim 55: “system 60 summarizes the complaint to filter emotional venting.”

1 used by participants in conjunction with the complaint handling apparatus
2 and method to record evidence needed to back up their complaints (col. 12,
3 ll. 26-32). Among the evidence that may be collected and appended to the
4 complaint includes audio, video, and satisfaction data (col. 12, ll. 35-40; 53-
5 60). At least the satisfaction data, by definition, would include emotional
6 state information.

7 Given the importance of emotions as disclosed in Online Resolution
8 and Eisen, and the collection of satisfaction data in Sloo, we agree with the
9 Examiner that the combined teachings of these references show that it was
10 known to include emotional state information in the complaint of Sloo.

11 Appellant argues that bodily incorporating Online Resolution and
12 Eisen into Sloo would not result in the claimed invention (Appeal Brief 10-
13 14; Declaration of Nora Femenia ¶¶ 13-14; Declaration of Christina Kallas
14 ¶¶ 12-13). As set forth above, however, the test of obviousness is not bodily
15 incorporation, but what the combined teachings of references would have
16 suggested to those of ordinary skill in art. *See In re Keller*, 642 F.2d at 425.
17 While Eisen in particular may disfavor online dispute resolution, we are
18 unpersuaded that this, or the results of a bodily incorporation of Eisen into
19 Sloo, suggests that adding emotional state information is either unknown or
20 the results unpredictable. *See KSR Int'l Co.*, 127 S. Ct. at 1731.

21 Accordingly, we sustain this rejection.

22
23 *Rejections of Claims 49 and 51*

24 Claims 49 and 51 depend from claim 46. Appellant has not set forth
25 any additional arguments as to why the Examiner erred in rejecting these

claims that are different from the argument set forth for claim 46.
Accordingly, this rejection is also sustained.

Rejections of Claims 59 and 60

Claims 59 and 60 depend from claim 55. Appellant has not set forth any additional arguments as to why the Examiner erred in rejecting these claims that are different from the argument set forth for claim 55.
Accordingly, this rejection is also sustained.

Obviousness Rejection of Claims 85, 88, and 89

We agree with Appellant concerning the narrow point that the Examiner improperly combined Sloo and Thiessen in an attempt to render obvious “automatically receiving, at the computer, a response to the at least one suggested remedy” as set forth in claim 85 (Appeal Brief 16-17). Contrary to the assertion on page 22 of the Examiner’s Answer, we agree with Appellant that this receiving of a response to the suggested remedy occurs *during* complaint preparation because the following recitation in claim 85 requires “automatically preparing, at the computer, the complaint *based on the information and the response received* from the complainer” (emphasis added). While method steps do not usually need to be executed in any particular order, the rule does not apply where the claim explicitly or implicitly requires a specific order. *See Interactive Gift Express, Inc.*, 256 F.3d at 1342-43. Because the complaint takes into account the response received from the complainer concerning the suggested remedy, the response to the suggested remedy in claim 85 must be provided *prior to* completion of the complaint generation.

1 The Examiner takes the position that Sloo does not disclose receiving
2 a response to the suggested remedy, but then cites Thiessen as correcting this
3 deficiency (Examiner's Answer 12). Even if Thiessen discloses receiving a
4 response to the suggested remedy, however, the Examiner has not provided
5 any showing as to how this response is received prior to completion of
6 complaint generation. Accordingly, the Examiner has not met the initial
7 burden of establishing a *prima facie* case of obviousness concerning this
8 aspect, and thus we are constrained to decide in favor of Appellant.

9 The rejection of claims 85, 88, and 89 in view of Sloo and Thiessen is
10 not sustained. The rejection of claims 86 and 87 are also not sustained for
11 the same reasons.

12 13 CONCLUSIONS OF LAW

14 The Appellant has not shown that the Examiner erred in holding that it
15 would have been obvious to a person of ordinary skill in the art in view of
16 the combined teachings of Sloo and Online Resolution to modify the Sloo
17 method so as to include the step of "automatically forwarding, from the
18 computer, the approved complaint, including the information identifying the
19 complainer, to the complaine.".

20 The Appellant has not shown that the Examiner erred in holding that it
21 would have been obvious to a person of ordinary skill in the art in view of
22 the combined teachings of Sloo, Online Resolution, and Eisen to modify the
23 Sloo method so as to include the steps of "automatically forwarding, at the
24 computer, preparing the complaint including emotional state information
25 based on the information received from the complainer."

The Appellant has shown that the Examiner erred in holding that it would have been obvious to a person of ordinary skill in the art in view of the combined teachings of Sloo and Thiessen to modify the Sloo method so as to include the steps of “automatically receiving, at the computer, a response to the at least one suggested remedy.”

DECISION

The Examiner's rejection of claims 46-63 is sustained. The Examiner's rejection of claims 85-89 is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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BRENDA POMERANCE
LAW OFFICE OF BRENDA POMERANCE
310 West 52 Street
Suite 27B
NEW YORK, NY 10019